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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602
21171	7590	11/17/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, DUSTIN	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,565

Applicant(s)

MIYAZAWA, YOSHINORI

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-8,10-14 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-8, 10-14, 16-21 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/29/2006 has been entered.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Hara [US Patent No 5,938,725].

4. As per claim 21, Hara discloses the invention as claimed including a method of transmitting an electronic mail [i.e. transmitting/receiving an electronic mail message among a

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plurality of computers connected via a network to each other] [Abstract; and col 1, lines 8-15],
comprising:

determining whether a reply destination of an electronic mail is part of a first mailing list having multiple destination addresses listed therein [i.e. extracts the mail address of the transmission destination candidate from the retrieved electronic mail messages, there are a mail address of desired destination, mail addresses of destinations of global address] [S3, Figure 2; Figure 4; col 3, lines 52-60; and col 7, lines 39-47]; and

generating a second mailing list responsive to a selection of at least one destination address from the first mailing list [i.e. selected by the selection means as the mail address of the transmission destination from the outputted mail addresses of the transmission destination candidates] [S4, Figure 2; Figure 4; col 3, lines 18-21; and col 7, lines 4-6] and transmitting a reply to the electronic mail using the second mailing list [i.e. the electronic mail can be transmitted to the apparatus having this mail address] [S5, Figure 2; col 3, lines 21-23; and col 7, lines 6-8].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Han et al. [US Patent No 5,872,925].

7. As per claim 19, Hara discloses the invention substantially as claimed including a method of broadcasting an electronic mail to e-mail terminal devices connected with a communication network, comprising:

storing a mailing list having destination addresses [i.e. address notebooks are used in order to manage mail addresses] [col 1, lines 17-28];

determining whether a reply destination of an electronic mail is part of a first mailing list having multiple destination addresses listed therein [i.e. extracts the mail address of the transmission destination candidate from the retrieved electronic mail messages, there are a mail address of desired destination, mail addresses of destinations of global address] [S3, Figure 2; Figure 4; col 3, lines 52-60; and col 7, lines 39-47].

Hara does not specifically disclose selectively broadcasting a reply in response to the electronic mail to e-mail terminal devices corresponding to one or more of the designated destination addresses of the mailing list using a single mail address responsive to a selection by a sender of the reply.

Han discloses selectively broadcasting a reply in response to the electronic mail to e-mail terminal devices corresponding to one or more of the designated destination addresses of the mailing list using a single mail address responsive to a selection by a sender of the reply [i.e. elect to send a Reply or Reply To All] [col 4, lines 27-39].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Han because Han's teaching of reply option to the received electronic mail would prevent a recipient from sending a reply to a message received from a sender to an address other than the sender's [Han, col 2, lines 28-30].

8. As per claim 20, Hara discloses the invention substantially as claimed including a method of transmitting an electronic mail, comprising:

determining whether a reply destination of an electronic mail is part of a first mailing list having multiple destination addresses listed therein [i.e. extracts the mail address of the transmission destination candidate from the retrieved electronic mail messages, there are a mail address of desired destination, mail addresses of destinations of global address] [S3, Figure 2; Figure 4; col 3, lines 52-60; and col 7, lines 39-47].

Hara does not specifically disclose selecting at least one destination address from the multiple destination addresses in the mailing list and transmitting a reply in response to the electronic mail received only to the at least one destination address in the mailing list based on said selecting.

Han discloses selecting at least one destination address from the multiple destination addresses in the mailing list and transmitting a reply in response to the electronic mail received only to the at least one destination address in the mailing list based on said selecting [i.e. elect to send a Reply or Reply To All] [col 4, lines 27-39].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Han because Han's teaching of reply option to the received

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electronic mail would prevent a recipient from sending a reply to a message received from a sender to an address other than the sender's [Han, col 2, lines 28-30].

9. Applicant's arguments with respect to claims 19-21 have been considered but are moot in view of the new ground(s) of rejection.

10. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Follansbee John can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen
Examiner
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A handwritten signature in black ink, appearing to read 'Dustin', with a long horizontal flourish extending to the right.